

10/815,004
END5096USNPRemarksStatus of Claims

Claims 1, 2, 4, 5, 8, 9, and 11-24 were rejected. Claims 1, 12, and 20 have been amended. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved. This amendment is being filed with a Request for Continued Examination (RCE), given that the rejection in the Office Action dated 12/27/2007 was made final.

§103 Rejections

Claims 1, 8-9, 11-15, and 17-19 were rejected under 35 U.S.C. §103(a) as being obvious over Barsch (U.S. 6,234,177) in view of Fischer (U.S. 5,286,257) further in view of Burbank et al. (U.S. 6,662,041). Claim 16 was rejected under 35 U.S.C. §103(a) as being obvious over Barsch in view of Burbank et al. ('041) in view of Fischer even further in view of Lamoreaux et al. (U.S. 6,554,760). Claims 2 and 6 were rejected under 35 U.S.C. §103(a) as being obvious over Barsch in view of Fischer in further view of Burbank et al. ('041) even further in view of Burbank et al. (U.S. 6,161,034). Claims 4-5 were rejected under 35 U.S.C. §103(a) as being obvious over Barsch in view of Fischer in further view of Burbank et al. ('041) even further in view of Zarins et al. (U.S. 6,605,047). Claims 20-21 and 24 were rejected under 35 U.S.C. §103(a) as being obvious over Barsch in view of Fischer in further view of Burbank et al. ('041) even further in view of Miller et al. (U.S. 6,638,235). Claims 22-23 were rejected under 35 U.S.C. §103(a) as being obvious over Barsch in view of Fischer in further view of Burbank et al. ('041) even further in view of Miller et al. even further yet in view of Zarins et al.

10/815,004
END5096USNP

Applicant appreciates the Office's courtesy in suggesting that Applicant further specify structural characteristics of the cutter in the claims, which applicant has done through the amendments made herein.

Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in each independent claim, such that an obviousness rejection based on the art of record cannot be sustained. For instance, Applicant notes that amended independent claim 1 recites a cutter seat portion on a marker deployment rod that is configured to abut the sharp open distal end of a hollow cutter, as well as an act of bringing the sharp open distal end of the cutter and the cutter seat portion into abutment. These limitations, among others recited in amended claim 1, are neither taught nor suggested by the combined art of record. For instance, given the further structural specificity given to the cutter in present claim 1, the Office can no longer reasonably rely on item 52 of Barsch or item 20 of Fischer as teaching a cutter as now claimed.

Applicant further objects to the Office's mischaracterization of the recited combination of a cutter and a marker deployment rod as being merely "a plunger that is separable into a deployment rod and a cutter," as well as the Office's reliance on the *In re Dulberg* case. First, Applicant notes that the deployment rod and cutter recited in amended claim 1 have significant structural differences with one another, and that the cutter serves a completely different function when used separately from the deployment rod. In particular, the cutter has a sharp open distal end that is configured to sever tissue. Amended claim 1 even recites an act of advancing the cutter to sever a tissue sample with this sharp open distal end. This sharp distal end is then recited as being brought into abutment with the cutter seat portion of the marker deployment rod, for deployment of a marker. The separate identity of the cutter and the deployment rod therefore has significance – the cutter could not perform its recited function of severing tissue if it were made integral with the deployment rod to form a "plunger" as suggested by the Office.

10/815,004
END5096USNP

Second, the present facts can be easily distinguished over the facts underlying the holding in the *In re Dulberg* case. In that case, the applicant was trying to claim a cap that was removable from a lipstick tube. The prior art taught a cap that was press-fit to a lipstick tube. The court held that it would have been obvious to make the prior art cap removable from the lipstick tube, in order to provide access to the end of the lipstick tube to which the cap was applied. 289 F.2d 522, 523-24 (CCPA 1961). However, in that case, the cap and the lipstick tube both performed the same functions regardless of whether they were separable or integral. By contrast, and as noted above, the cutter recited in amended claim 1 serves a function when it is separate from the deployment rod (i.e., severing tissue) that is completely independent and different from the function it serves when engaged with the deployment rod (i.e., driving the rod to deploy a marker). The *In re Dulberg* case therefore cannot be reasonably relied on for a sweeping and categorical proposition that the limitations relating to the cutter and deployment rod of amended claim 1 are *per se* unpatentable.

Furthermore, an obviousness rejection cannot be sustained where a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose or change the principle of operation of the prior art invention being modified. MPEP 2143.01. Applicant submits that modifying the plunger 52 of Barsch and the plunger 20 of Fischer to meet the cutter limitations now recited in amended claim 1 would render the Barsch and Fischer devices unsatisfactory for their intended purposes and change their principles of operation. One of ordinary skill in the art would therefore not have been motivated to make such modifications. MPEP 2143.01.

In view of the foregoing, Applicant respectfully submits that the combined art of record fails to render present claim 1 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 12 recites a marker deployment rod having a cutter seat configured for abutment with the sharp open distal end of a hollow cutter. These limitations, among others recited in amended claim 12, are neither taught nor suggested by the combined

10/815,004
END5096USNP

art of record. Accordingly, and for at least the same reasons stated above with respect to similar language in amended claim 1, Applicant respectfully submits that the combined art of record fails to render present claim 12 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 20 recites a cutter seat on a marker introduction pusher that is configured to abut the sharp open distal end of a hollow cutter. These limitations, among others recited in amended claim 20, are neither taught nor suggested by the combined art of record. Accordingly, and for at least the same reasons stated above with respect to similar language in amended claim 1, Applicant respectfully submits that the combined art of record fails to render present claim 20 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Conclusion

10/815,004
END5096USNP

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims that are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

/Andrew B. Ulmer/
Andrew B. Ulmer
Reg. No. 57,003
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535